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EXAMINER

SHELEHEDA, JAMES R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,032	Applicant(s) ISHIDA ET AL.	
	Examiner JAMES SHELEHEDA	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 08/04/08 have been fully considered but they are not persuasive.

a. In response to applicant's arguments, in regards to claim 1 and 7, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Inoue discloses a recording system wherein, if the system cannot automatically select any one of the first through n-th recording means because none of said recording means is available for the time slot corresponding to said recording reservation (column 11, lines 1-16), the system will prompt the user to select one of said recording means to which to make said recording reservation (column 11, lines 1-16).

DeFreese discloses when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations, the user is presented with information identifying the content of each previously made recording reservation that conflicts with said recording reservation (Fig. 12 and 21; column 21, line 42-column 22, line 17).

Therefore, applicant's arguments are not convincing as the *combination* of Inoue and DeFreese disclose the claim limitations.

b. In response to applicant's arguments, in regards to claim 10, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Inoue discloses a recording system wherein, if the system cannot automatically select any one of the first through n-th recording means because none of said recording means is available for the time slot corresponding to said recording reservation (column 11, lines 1-16), the system will prompt the user to select one of said recording means to which to make said recording reservation (column 11, lines 1-16).

DeFreese discloses when the time slot corresponding to said recording reservation conflicts with a time slot of a previously made recording reservation for recording onto said another recording means, said previously made recording reservation is canceled, and said recording reservation does not conflict with any other previously made recording reservation for recording to said another recording means (Fig. 12 and 21; column 21, line 42-column 22, line 17).

Finally, Toshiya discloses automatically switching a recording reservation made to any one recording means to another recording means (see Abstract).

Therefore, applicant's arguments are not convincing as the *combination* of Inoue, DeFreese and Toshiya disclose the claim limitations.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (7,123,813) (of record) in view of DeFreese et al. (DeFreese) (6,493,876) (of record).

As to claim 1, Inoue discloses a recording apparatus (Fig. 1) comprising:

first through n-th recording means (Fig. 1, 104-106) for recording input broadcast contents to a recording medium (column 3, lines 31-45);

user interfacing means (Fig. 3) for inputting an instruction of a user to reserve a recording of a broadcast content (column 6, lines 1-18); and

reservation managing means (216) which manages reservations of broadcast content recordings with respect to each of said first through n-th recording means (column 6, lines 25-35 and column 10, lines 11-20) and which, when making a reservation of a broadcast content recording in accordance with the recording reservation instruction input through said user interfacing means, selects automatically one of the first through n-th recording means available for a time slot corresponding to the recording reservation (column 9, lines 6-22 and column 10, lines 41-67), in order to

make said recording reservation to the selected recording means (column 9, lines 6-22 and column 10, lines 58-67).

While Inoue discloses wherein, if said reservation managing means cannot automatically select any one of the first through n-th recording means because none of said recording means is available for the time slot corresponding to said recording reservation to be made in accordance with said recording reservation instruction input through said user interfacing means (column 11, lines 1-16), then said user interfacing means performs a selection requesting process for prompting said user to select one of said recording means to which to make said recording reservation (column 11, lines 1-16), he fails to specifically disclose when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations, the user is presented with information identifying the content of each previously made recording reservation that conflicts with said recording reservation.

In an analogous art, DeFreese discloses a recording reservation system (see Fig. 12 and 24; column 21, lines 1-67) which will determine when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations and present the user with information identifying the content of each previously made recording reservation that conflicts with said recording reservation (Fig. 12 and 21; column 21, line 42-column 22, line 17) for the typical benefit of alerting the subscriber to overlapping programming and providing the opportunity to correct the problem (column 21, line 64-column 22, line 17).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Inoue's system to include when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations, the user is presented with information identifying the content of each previously made recording reservation that conflicts with said recording reservation, as taught by combination with DeFreese, for the typical benefit of alerting the subscriber to overlapping programming and providing the opportunity to correct the problem.

As to claim 2, Inoue and DeFreese disclose said user interfacing means performs a selection requesting process for prompting said user to select one of said recording means to which to make said recording reservation (column 11, lines 1-16).

As to claim 4, Inoue and DeFreese disclose wherein, if said user selects one of said recording means to which to make said recording reservation in response to said selection requesting process performed by said user interfacing means (column 11, lines 1-16), then said reservation managing means makes said recording reservation to the user selected recording means (column 11, lines 1-16).

As to claim 7, Inoue discloses a recording reservation processing method for use with a recording apparatus (column 3, lines 31-45) having first through n-th recording

means for recording input broadcast contents to a recording medium (Fig. 1), said recording reservation processing method comprising the steps of:

inputting an instruction to reserve a broadcast content recording based on operations by a user (column 8, lines 35-42);

automatically selecting from said first through n- th recording means recording means available for a time slot corresponding to the recording reservation designated by said instruction input in the inputting step (column 9, lines 6-22 and column 10, lines 41-67); and

making said recording reservation to the recording means selected automatically in the automatically selecting step, said recording reservation being designated by said instruction input in the inputting step (column 9, lines 6-22 and column 10, lines 58-67).

While Inoue discloses wherein, if said reservation managing means cannot automatically select any one of the first through n-th recording means because none of said recording means is available for the time slot corresponding to said recording reservation to be made in accordance with said recording reservation instruction input through said user interfacing means (column 11, lines 1-16), then said user interfacing means performs a selection requesting process for prompting said user to select one of said recording means to which to make said recording reservation (column 11, lines 1-16), he fails to specifically disclose when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations, the user is presented with information identifying the content of each previously made recording reservation that conflicts with said recording reservation.

In an analogous art, DeFreese discloses a recording reservation system (see Fig. 12 and 24; column 21, lines 1-67) which will determine when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations and present the user with information identifying the content of each previously made recording reservation that conflicts with said recording reservation (Fig. 12 and 21; column 21, line 42-column 22, line 17) for the typical benefit of alerting the subscriber to overlapping programming and providing the opportunity to correct the problem (column 21, line 64-column 22, line 17).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Inoue's system to include when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations, the user is presented with information identifying the content of each previously made recording reservation that conflicts with said recording reservation, as taught by combination with DeFreese, for the typical benefit of alerting the subscriber to overlapping programming and providing the opportunity to correct the problem.

As to claim 8, Inoue and DeFreese disclose requesting said user to select recording means to which said recording reservation is to be made (column 11, lines 1-16); and

if said user selects in the selection requesting step the recording means to which to make said recording reservation, then making said recording reservation a second time to the user-selected recording means (column 11, lines 1-16).

As to claim 3, Inoue and DeFreese disclose wherein, when performing said selection requesting process, said user interface means also carries out a process for presenting the time slot applicable to the broadcast content to be reserved for unattended recording (Fig. 12 and 21; displaying a detected timing conflict), and any previously made recording reservation overlapping either partially or totally with said time slot (see Fig. 12 and 21; column 21, line 42-column 22, line 17).

4. Claims 5, 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue and DeFreese and further in view of Toshiya et al. (JP 2001-160256) (provided by applicant).

As to claim 5, while Inoue and DeFreese disclose wherein said reservation management means automatically creates a recording reservation for one recording means and another recording means (multiple recorders, each receiving different programs to record; column 10, line 41-column 11, line 16), they fail to specifically disclose automatically switching a recording reservation made to any one recording means to another recording means.

In an analogous art, Toshiya discloses a recording system for automatically reserving video recordings (see Abstract) wherein the system will automatically handle updates to recording reservations (see Abstract) by automatically switching a recording

reservation from a first recording list to a second recording list (see Abstract) to allow the system to deal with changes made to a TV program (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Inoue and DeFreese's system to include automatically switching a recording reservation made to any one recording means to another recording means, as taught by combination with Toshiya, for the typical benefit of allowing the system to deal with changes made to a TV program and thus optimizing the use of the recorder by ensuring that newly available slots in its recording schedule are utilized.

As to claim 10, while Inoue discloses a recording reservation processing method for use with a recording apparatus (column 3, lines 31-45) having first through n-th recording means for recording input broadcast contents to a recording medium (Fig. 1), said recording reservation processing method comprising the steps of:

making a reservation of a broadcast content recording to any one of said first through n-th recording means (column 10, line 41-column 11, line 16), he fails to specifically disclose automatically switching a recording reservation made to any one recording means to another recording means and when the time slot corresponding to said recording reservation conflicts with a time slot of a previously made recording reservation for recording onto said another recording means, said previously made recording reservation is canceled, and said recording reservation does not conflict with

any other previously made recording reservation for recording to said another recording means.

In an analogous art, DeFreese discloses a recording reservation system (see Fig. 12 and 24; column 21, lines 1-67) which will determine when the time slot corresponding to said recording reservation conflicts with the time slot of previously made recording reservations and will cancel the previously made recording reservation (Fig. 12 and 21; column 21, line 42-column 22, line 17) for the typical benefit correcting the problem when recording overlaps occur (column 21, line 64-column 22, line 17).

Additionally, in an analogous art, Toshiya discloses a recording system for automatically reserving video recordings (see Abstract) wherein the system will automatically handle updates to recording reservations (see Abstract) by automatically switching a recording reservation from a first recording list to a second recording list (see Abstract) to allow the system to deal with changes made to a TV program (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Inoue's system to include when the time slot corresponding to said recording reservation conflicts with a time slot of a previously made recording reservation for recording onto said another recording means, said previously made recording reservation is canceled, and said recording reservation does not conflict with any other previously made recording reservation for recording to said another recording means, as taught by combination with DeFreese, for the typical

benefit of alerting the subscriber to overlapping programming and providing the opportunity to correct the problem.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Inoue and DeFreese's system to include automatically switching a recording reservation made to any one recording means to another recording means, as taught by combination with Toshiya, for the typical benefit of allowing the system to deal with changes made to a TV program and thus optimizing the use of the recorder by ensuring that newly available slots in its recording schedule are utilized.

As to claims 6 and 11, Inoue, DeFreese and Toshiya disclose wherein, if a recording reservation made to a particular one of said first through n-th recording means is canceled (see Toshiya Abstract), then the switching step switches automatically another recording reservation made to another recording means (one of the plurality of storage mediums reserving programming; see Inoue at column 10, line 41-column 11, line 16) to that particular recording means (moving the reservation from the second list to the first; see Toshiya Abstract).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2623

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda
Examiner, Art Unit 2424

JS

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623